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JAN 08 2007

OFFICE OF PETITIONS

In re Application of :
Chang et al. : DECISION ON APPLICATION
Application No. 09/827,500 : FOR
Filed: April 6, 2001 : PATENT TERM ADJUSTMENT
Atty Docket No. 103594.00002 :

This is a decision on the "REQUEST FOR RECONSIDERATION OF THE DECISION ON THE APPLICATION FOR PATENT TERM ADJUSTMENT" filed October 30, 2006. Applicants request reconsideration of the decision on application for patent term adjustment mailed October 2, 2006.

The request for reconsideration of decision on application for patent term adjustment is GRANTED to the extent indicated herein. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

Prior to a decision being rendered on this request, the patent issued with a revised patent term adjustment of 506 days. This included entry of a period of adjustment of 207 for the Office taking in excess of 3 years to issue the patent.

For the reasons stated herein, the patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of five hundred twenty-one (521) days.

On March 9, 2006, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment

(PTA) to date is 0 days. On June 6, 2006, applicants timely filed the initial application for patent term adjustment. By decision mailed October 2, 2006, the application for patent term adjustment was granted to the extent that the initial determination of patent term adjustment was corrected to two hundred sixty-three (263) days (not 464 days as requested by applicants).

On instant renewed petition, applicants again allege that the Office erred in charging 301 days of delay against applicant and request additional days of patent term adjustment. Applicants point out that the Office action mailed February 27, 2004, was in fact mailed to a wrong address. In addition, applicants point out what they deem to be inconsistencies in the transaction history of PAIR and the image file wrapper.

Preliminarily, applicants are advised that there are line item entries in PAIR (such as "Non-Final Rejection" usually preceding "Mail Non-Final Rejection"), which will have no corresponding papers in IFW. The patent term adjustment calculations are not based on such entries. The calculation is based on the date of mailing of Office actions/notices and the date of receipt of applicant responses. Thus, on application for patent term adjustment, the undersigned will make a careful review of the dates of mailing and dates of receipt of such papers.

As to the disputed 301 days of applicant delay, it is specifically noted that the determination that the patent term adjustment needed correction to 263 days was based on correction of the period of reduction for applicant delay from 301 days to 4 days. Applicants do not now dispute the correction to 4 days. Thus, reconsideration of this calculation is unnecessary.

Rather, on previous decision, entry of a period of adjustment of 222 days was determined not to be warranted because of a conclusion that the Office action mailed February 27, 2004 was properly mailed to the correspondence address of record. This is the basis of applicants' dispute. On instant renewed petition, applicants correctly point out that the Office action was mailed to the wrong address. Thus, there was examination delay within the meaning of 1.702(a)(2). It is concluded that a period of adjustment of 222 days is proper for the Office taking until December 20, 2004 to take action in response to applicants' response filed January 12, 2004.

However, given entry of the 222 days for Office delay, entry of a period of adjustment of 207 days for the Office taking in excess of three years to issue the patent is not warranted.

It is agreed that the instant patent issued 3 years and 952 days after its filing date. However, § 1.703(b)(1) provides, in pertinent part that:

the period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) ... and ending on the date a patent was issued, but not including the sum of the following periods:

(1) The number of days, if any, in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued;

Thus, the filing of a request for continued examination (RCE) cuts-off the applicants' ability to accumulate any additional patent term adjustment against the three-year pendency provision, but does not otherwise affect patent term adjustment.

In this instance, a first RCE was filed on August 24, 2005. Thus, the ability to accumulate additional patent term adjustment against the three-year pendency provision ended August 24, 2005. Accordingly, the period of adjustment under § 1.702(b) is 505 days, counting the number of days beginning on April 7, 2004 and ending on August 24, 2005.

Moreover, if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap, with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also Revision of

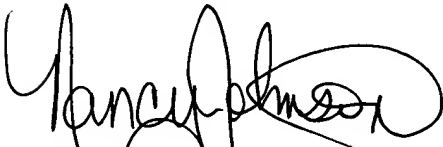
Patent Term Extension and Patent Term Adjustment Provisions; Final Rule, 69 Fed. Reg. 21704 (April 22, 2004). In this instance, the periods of delay totalling 556 days attributable to grounds specified in § 1.702(a)(1), (2) and (4) overlap with the 505 days attributable to the delay in the issuance of the patent. Thus, the period of adjustment cannot exceed the actual number of days of delay of 556 days.

In view thereof, the patent should have issued with a revised patent term adjustment of five hundred twenty-one (521) days. (556 days of Office delay reduced by 35 days of applicant delay).

No fee is required on instant petition for reconsideration of decision on patent term adjustment and no fee has been charged.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by five hundred twenty-one (521) days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a large, stylized loop at the end.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,136,846 B2
DATED : November 14, 2006
INVENTOR(S) : Chang et al.

DRAFT

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (506) days

Delete the phrase "by 506" and insert – by 521 days--